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|---|--|---|-------------------------------|
| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>  |  | Docket Number (Optional)<br>JP920000426US1  |                               |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]<br><br>on _____<br><br>Signature _____<br><br>Typed or printed name _____   |  | Application Number<br>09/892,147  | Filed<br>08/26/2001           |
|   |  | First Named Inventor<br>Anatole Shamrakov   |                               |
|   |  | Art Unit<br>3628  | Examiner<br>Clement B. Graham |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.<br><br>This request is being filed with a notice of appeal.<br><br>The review is requested for the reason(s) stated on the attached sheet(s).<br>Note: No more than five (5) pages may be provided.  |  |   |                               |
| I am the<br><input type="checkbox"/> applicant/inventor.<br><input type="checkbox"/> assignee of record of the entire interest.<br>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)<br><input checked="" type="checkbox"/> attorney or agent of record. 35,129<br>Registration number _____<br><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br>Registration number if acting under 37 CFR 1.34 _____ |  | <i>Anthony V.S. England</i><br>Signature<br>Anthony V.S. England<br>Typed or printed name<br>512-477-7165<br>Telephone number<br>4-6-2008<br>Date |                               |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.   |  |   |                               |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.   |  |   |                               |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Filed: June 26, 2001

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APR 07 2008

In re the application of: Shamrakov )

Filed 06/26/2001 )

Group Art Unit: 3692

For: Integration of Computer )  
Applications and E-Business )  
Capability )

Examiner: Clement B. Graham

Appl. No.: 09/892,147 )

Applicant's Docket: )  
JP920000426US1 )**ARGUMENTS FOR PRE-APPEAL BRIEF REVIEW****Issue 1:**

Claims 4-7, 9, 14-17, 19 and 21-22 stand rejected under 35 USC 103(a) as being anticipated by US Patent 6,963,847 ("Kennedy"), in view of US Patent Application Publication US2002/0042755 ("Kumar").

As in the two immediately preceding Office actions, the Final Office Action does not explain the *pertinence* of the specific parts of the primary reference relied upon for the rejection. Applicant submits that the Kennedy reference relied upon for the rejection is complex and describes inventions other than that claimed by Applicant, but the Office Action does not explain the specific parts of the reference relied upon for rejection of each specific element or step and the pertinence of the specific parts. Applicant contends that such rejection is improper. 37 CFR 1.104 (c)(2); MPEP 707.

As before, the Final Office Action relies upon a single, long set of passages for numerous claim segments with no explanation as to the pertinence of the passages. In particular, the Final Office Action divides each of the independent claims 21 and 22 into seven segments, in a fashion like the two prior Office actions. To meet the first six segments for each of claims 21 and 22, the Office action repeatedly cites the same set of passages in Kennedy, which have a total of more than 3600 words. The repeated cites never explain pertinence. For example, regarding one 52 word segment of claim 21, the Office action points to this 3600+ word portion of Kennedy with no explanation of pertinence. Applicant submits that the mere length of the portion indicates on its face that Kennedy is complex and its pertinence not apparent. Further, Kennedy describes

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inventions other than that claimed by Applicant. For example, the present application makes no mention of "order quantity constraints" that do not allow a fulfillment server to reduce a quotation quantity without affecting validity of quotation, nor does the present application mention "cancellation restrictions," as described by Kennedy, col. 7, lines 30-45. Therefore, the examination is not complete with respect to the patentability of the invention as claimed.

Further, the same 3600+ part of Kennedy is also pointed out in the Final Office Action for the rejection of each and every one of the 10 dependent claims. Overall, this same set of 3600+ words is identically cited over 20 times in the Office action. Further, no other parts of Kennedy are cited. The Office action offers no specific explanation about the significance of individual portions of the 3600+ word portion of Kennedy in any of the 20+ citations. Applicant submits that on its face this further indicates that the pertinence of Kennedy is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Based on the above, Applicant submits that the rejections in the Final Office action are improper and respectfully requests that if the claims are not allowed, then prosecution should be re-opened, wherein a new Office action is issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific Parts*.<sup>1</sup>

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<sup>1</sup> Note also that Applicant received no response to a written request for telephone interview about this matter in Applicant's reply of October 26, 2007, nor to subsequent telephone voice messages left for the Examiner requesting either i) assurance that the amended claims would be allowed, ii) guidance as to Examiner's position regarding a number of specific questions, or iii) assurance a new Office Action would be issued properly setting out specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*, in a manner responsive to each of the numerous specific questions. Instead, the Final Office Action was issued, in which two new references were substituted for two prior references, but with the same lack of explanation as described herein above. Some of the specific questions for which Applicant requested guidance are set out for illustration as follows:

Regarding the first hosting service step ... What specific process taught by [the cited references] does the rejection rely upon for the claimed first shopping process that is on a data center host computer system, that is accessible to shoppers by Internet communications and that communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales, where the first shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected first hosting service step being performed on the host computer system?

Note that claim also states that the claimed first integration process is on a *host computer system located remotely* from the data center. What specific process taught by [the cited references] does the rejection rely upon for the claimed *first integration process*? What specific host computer system taught by [the cited references] does the rejection rely upon for this *remotely located host computer system*?

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## Issue 2:

The Final Office Action rejects claims 21 and 22 under 35 USC 112, second paragraph on grounds that "customers selecting from among the first, second third, fourth, fifth and sixth hosting service" is indistinct because it is indeterminate whether the first, second third, fourth, fifth and sixth hosting services are the same or different hosting services. Applicant respectfully submits that the claims clearly and distinctly recite six respectively different hosting services.

With regard to the first three hosting services, claim 21 states "the first shopping process performs ...a first hosting service ...the second resource planning process performs ...a second hosting service ...the second integration process performs ...a third hosting service ..." Claim 22 has similar language. At least because the claims explicitly recite that the three hosting services are performed by respectively different processes, it is clear that these three hosting services are not the same.

Regarding the fourth hosting service, claim 21 recites that this includes "coupling communications between the second resource planning process [which performs the second hosting service, as the claim explicitly states] and a second shopping process [which is a process not recited in the claim for hosting services other than the fourth]." Claim 22 recites similar language. For at least this reason, it is clear the fourth hosting service is different than the others.

Regarding the fifth hosting service, claim 21 recites that this includes "coupling communications between the first shopping process [which performs the first hosting service, as the claim explicitly states] and a third resource planning process [which is a process not recited in the claim for hosting services other than the fifth]." Claim 22 recites similar language. For at least this reason, it is clear the fifth hosting service is different than the others.

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Note that the claim also states that the claimed first resource planning process is on a *host computer system located remotely* from the data center. What specific process taught by [the cited references] does the rejection rely upon for the claimed *first resource planning process*? What specific host computer system taught by [the cited references] does the rejection rely upon for this *remotely located host*?

Regarding the second hosting service step ... What specific process taught by [the cited references] does the rejection rely upon for the claimed *second resource planning process* that is on the data center host computer system and that communicates with a production process via Internet or dedicated link communications? What specific process taught by [the cited references] does the rejection rely upon for the claimed *production process*? Note that the claim also states that the production process is on a host computer located remotely from the data center. What specific host computer system taught by [the cited references] does the rejection rely upon for this *remotely located host*?

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Regarding the sixth hosting service, claim 21 recites that this includes "coupling communications between a certain process [which is a process not recited in the claim for hosting services other than the sixth] and a third shopping process [which is a process not recited in the claim for hosting services other than the sixth]." Claim 22 recites similar language. For at least this reason, it is clear the sixth hosting service is different than the others.

Issue 3:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Neither Kennedy nor Kumar, nor their combination, teach or suggest all the limitations of claims 21 or 22.

Kennedy teaches that a client submits line item requests pertaining to a specific product purchase at a fulfillment server. See, e.g., Kennedy, col. 5, lines 13-26. The fulfillment server in turn brokers component requests corresponding to these line-items to "available to purchase" servers using a "local fulfillment manager" interface and a network. *Id.* The LFM uses the ATP servers to perform computations and record reservations and provides resulting quotations to the fulfillment server, which presents a unified overall quotation to the requesting client. *Id.* The fulfillment server may "maintain information regarding suppliers ...which fulfillment server 16 may use for order promising ..." This includes maintaining definitions for suppliers at fulfillment server 16." Kennedy, col. 7, lines 30-45.

However, neither Kennedy nor Kumar, nor their combination, teach or suggest the following:

- ... a first shopping process on the data center host computer system ...perform[ing] ...a first hosting service ...communicating with a first integration process and a first resource planning process via Internet communications to transact first sales, wherein the first resource planning process is ...located remotely from the data center and the first integration process is ...located remotely from the data center;
- ... a second resource planning process on the data center host computer system ...perform[ing] ...a second hosting service ...communicating with a production process via Internet or dedicated link communications, wherein the production process is ...located remotely from the data center;
- ...a second integration process on the data center host computer system ...perform[ing] ... a third hosting service ...coupling communications between the first shopping process and the second resource planning process [i.e., on the data center host] to transact second sales;

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a fourth hosting service ...coupling communications between the second resource planning process and a second shopping process ...of a second shopping application accessible to shoppers by Internet communications ...located remotely from the data center ...to transact third sales;

a fifth hosting service ...coupling communications between the first shopping process and a third resource planning process to transact fourth sales, wherein the third resource planning process is ...located remotely from the data center;

a sixth hosting service ...coupling communications between a certain process and a third shopping process, wherein the third shopping process is ...accessible to shoppers ...on a host computer located remotely from the data center and the certain process is a process ...located remotely from the data center; and

...performing a hosting service by the host computer system responsive to one of the customers selecting from among the first, second third, fourth, fifth and sixth hosting service ...and wherein sales are transacted with shoppers for the customers responsive to ones of the selected hosting service steps being performed on the host computer system,

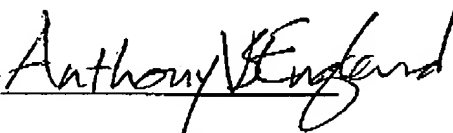
as recited in claim 21. For at least this reason, Applicant submits that claim 21 is patentably distinct. Claim 22 has similar language, according to the form of the invention it claims.

Therefore, Applicant submits that claim 22 is, likewise, patentably distinct. Claims 4-7, 9, 14-17 and 19 are allowable at least because they depend on allowable claims 21 or 22.

#### REQUEST FOR ACTION

Based on the above arguments, Appellant requests that claims 4-7, 9- 14-17, 19 and 21-22 of the present application be allowed and the application promptly be passed to issuance.

Respectfully submitted,

By 

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